

REMARKS

Applicants note that a Request for Continued Examination (RCE) pursuant to 37 C.F.R. §1.114 and a suspension of action up to three months was filed on September 29, 2006. Further, this Preliminary Amendment is being timely filed within the three-month suspension of action. Thus, this Preliminary Amendment is being timely filed.

Status of Claims

Applicants note that a first Amendment was filed on September 29, 2006.

In the present (second) Preliminary Amendment, claims 2-5, 7, 8, 12, and 15-18 are canceled without prejudice or disclaimer of the subject matter contained therein. Also, claims 19-31 have been added. Thus, claims 1, 6, 9-11, 13, 14 and 19-31 are pending in the above-identified application.

Support for the changes to claim 1 is found at pages 5-6 of the present specification. The other amendments are obviously editorial in nature. Support for new claims 19-31 is found, for example, at pages 5, 6 and 16-19 of the present specification. No new matter has been added with these amendments and new claims.

Distinctions over Previously Cited References

All of the previously submitted remarks in the Submission under 37 CFR 1.114 filed with the RCE on September 29, 2006 also apply with respect to the present claims and are deemed repeated herein.

It is further emphasized that Kotani '560 (USP 5,700,560) and Kotani '093 (USP 3,316,093) fail to disclose or suggest the combination of a gas barrier layer disposed on an inner face of an inner liner layer. Further, these references provide no basis for a motivation, *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991), to one skilled in the art to attempt to make such a structure, since these references are directed to food packaging rather than tires. Regarding these references directed to food packaging instead of tires, the Federal Circuit in *In re Oetiker* stated:

We have reminded ourselves and the PTO that it is necessary to consider “the reality of the circumstances”, *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) -- in other words, common sense -- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

24 USPQ2d 1443, 1446 (Fed. Cir. 1992) (citing *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985)).

In addition Kaido '123 (USP 6,136,123) fails to disclose or suggest the combination of a gas barrier layer and an inner liner layer. Kaido '123 further requires the presence of a “tackifier-adhesive” composition layer in order to join the thermal plastic film to the tire as noted, for example, at column 4, lines 54-65. A corresponding adhesive layer is not required by the present invention. Also, the background section of the Kaido '123 reference describes that when the adhesive strength at the splice portion of the film is poor, the splice portion will open up at the time of vulcanization of the tire, and working efficiency is deteriorated, when the thermoplastic film is formed on an inner face of a tire member. Thus, Kaido '123 fails to disclose or suggest the combination of a gas barrier layer and an inner liner layer

Consequently, numerous patentable distinctions exist between the present invention and the previously cited references.

Favorable action on the pending claims is respectfully requested.

If any questions arise in the above matters, please contact Applicant's representative, Andrew D. Meikle (Reg. No. 32,868), in the Washington Metropolitan Area at the phone number listed below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees. It is believed that no fee is due with the present response, as the present response is being filed within the three month period of suspension of action (see comments above).

Dated: December 29, 2006

Respectfully submitted,

By  #48,501
for Andrew D. Meikle

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